

Amendment and Response

Applicant: Peter J. Fritz

Serial No.: 10/081,794

Filed: February 21, 2002

Docket No.: M120.169.103 (54666US006)

Title: METHOD FOR ATTACHING A FASTENER TO A SURFACE TREATING MEMBER, AND SUCH AN ARTICLE HAVING A FASTENER

REMARKS

This is responsive to the Final Office Action mailed January 25, 2005 and the Advisory Action mailed March 29, 2005. In the Final Office Action, claims 31-40 and 43-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al., U.S. Patent No. 3,562,968 ("Johnson") in view of Gugle et al., U.S. Patent No. 4,636,124 ("Gugle").

Claims 31-40 and 43-55 are pending in the application and are presented for consideration and allowance.

35 U.S.C. § 103 Rejections

The Examiner rejected claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Gugle. Claim 31 relates, in part, to a method for attaching a fastener to a surface conditioning member by inducing relative rotation between the fastener and the surface conditioning member with a layer of thermoplastic adhesive in contact with a planar surface of the fastener and the surface conditioning member, so as to soften the layer of adhesive to form a bond between the fastener and the surface conditioning member. The method also includes stopping the relative rotation between the fastener and the surface conditioning member. For at least the reasons described below, it is believed that a *prima facie* case of obviousness has not been shown.

In response to previously-presented arguments that a requisite suggestion or motivation to modify Johnson in view of Gugle does not exist, the current Office Action states that "it should be noted that providing a more secure connection between the fastener and the surface conditioning member [of Johnson] would only be one of several motivations for combining the references." OA 1-25-05 at 2. The March 29, 2005 Advisory action cites column 1, lines 5-9 of Gugle as support for this alleged motivation. However, the cited language relates to increasing adhesion on wood and painted surfaces. Johnson does not describe its surface treating tool as including wood or a painted surface. Thus, the language relied upon for providing a requisite

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motivation to modify Johnson does not apply, and in fact teaches away from the combination being advanced.

The Advisory Action further advances a position that “another motivation” to modify Johnson in view of Gugle would be “to ensure the spread of adhesive complete along the areas of contact between the two surfaces to be adhered.” However, this alleged motivation arises only in the context of an improved spin welding technique (i.e., the ribbed configuration of Gugle “ensures the spread of adhesive” in the context of a welding technique in which a heat activated pellet is placed at the center of a friction weld fastener that is subjected to rotation (Gugle, col. 1, ll. 10-35)). Johnson does not describe an adhesive pellet-based welding technique, nor does it describe a spin welding technique. Because Johnson does not use adhesive pellet friction welding, the “spread of adhesive” concern raised (and purportedly solved) by Gugle does not apply to Johnson. Thus, the additional “motivation” described in the Advisory Action does not support modifying Johnson in view of Gugle.

In summary, regardless of whether Gugle discloses friction welding, there must be some motivation to combine Gugle with Johnson. The fact that Gugle discloses friction welding does not mean one having ordinary skill in the art would combine such a teaching with Johnson. It is respectfully believed that the Examiner’s position that Gugle can, in theory, be combined with Johnson fails to provide any requisite motivation to combine. MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)) (emphasis added). Thus, it is respectfully presented that a *prima facie* case of obviousness has not been established as it is improper to combine references when they simply can be combined, and no specific motivation for such a combination has been provided.

In light of the above, it is respectfully submitted that the rejection of claim 31 has been traversed, and that claim 31 is in a condition for allowance. For at least these same reasons, claims 32-40 and 43-52, otherwise depending from claim 31, are also allowable over the cited references. In addition, it is noted that claims 49-51 recite additional limitations relating to coating the layer of adhesive onto either the back surface of the conditioning member or the planar surface of the fastener prior to the step of inducing relative rotation between the fastener

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and the surface conditioning member. In contrast, neither Johnson nor Gugle describe “coating” an adhesive layer prior to rotation (i.e., with Gugle, an adhesive pellet is caused to melt with rotation, such that any “coating” does not occur prior to rotation). Thus, it is respectfully submitted that claims 49-51 recite additionally allowable subject matter.

Newly added claim 53 depends from independent claim 31. Therefore, it is believed allowable for at least the reasons set forth above. Additionally, claim 53 incorporates limitations noted by the Examiner as being absent from claim 31. In particular, at page 3 of the Final Office Action, the Examiner notes the “Applicant only recites a planar surface, and not a surface that is planar and parallel to the surface conditioning member.” Therefore, it is believed that newly added claim 53 is further distinguishable from the cited references by incorporating such a limitation.

Newly added claim 54 ultimately depends from claim 31, and thus for at least the reasons previously described, is allowable. In addition, claim 54 recites the step of placing the sheet of adhesive between the fastener and the surface conditioning member prior to inducing rotation between the fastener and the surface conditioning member. In contrast, and according to the reasoning of the Final Office Action, none of the cited references teach or suggest this additional step (page 3, paragraph c.i. of the Final Office Action recognizes that the adhesive pellet of Gugle forms a “sheet” only after melting (and thus only after rotation has begun)). Thus, it is respectfully submitted that claim 54 recites additionally allowable subject matter.

Newly added claim 55 ultimately depends from claim 31, and thus for at least the reasons previously described is allowable. In addition, claim 55 recites the additional step of placing the annulus of adhesive between the fastener and the surface conditioning member prior to rotation. As set forth in the Final Office Action, the adhesive pellet of Gugle would not define an “annulus” until after rotation (and thus melting) was initiated. Therefore, claim 55 recites additionally allowable subject matter.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 31-40 and 43-55 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the claim rejections and allowance of claims 31-40 and 43-55 is respectfully requested.

Applicants hereby authorize the Commissioner for Patents to charge Deposit Account No. 50-0471 in the amount of \$150.00 to cover the fees as set forth under 37 C.F.R. 1.16(b)(c).

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Melissa E. Buss at Telephone No. (651) 733-0649, Facsimile No. (651) 736-3833, or Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 25th day of April, 2005.

By

Timothy A. Czaja
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